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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,899	01/27/2000	William R. Wells	3735-929	9213
27717	7590	09/07/2005	EXAMINER	
SEYFARTH SHAW LLP 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			MAHMOUDI, HASSAN	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,899

Applicant(s)

WELLS ET AL.

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-13, 15-17, 19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-13, 15-17, 19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission filed on 09-June-2005 and the accompanying amendment, have been entered.

Remarks

2. In response to amendment filed on 09-June-2005, claims 1, 8, 15, 24 and 30 are amended per applicant's request. Claims 1-3, 5-6, 8-13, 15-17, 19, and 21-30 are presently pending in the application, of which, claims 1, 8, 15, and 21-24 are presented in independent form.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 21-23 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 21 and 22 recite the limitation “creating a first authenticator.” The specification does not describe the “creation of authenticator(s)” in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 recites the limitation “electronic transfer” is steps (d) through (f). The specification does not describe the “electronic transfer” in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from either claim 23 or the disclosed specification whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

5. Claims 21-23 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21 and 22 recite the limitation "creating a first authenticator." The specification does not describe the "creation of authenticator(s)" in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 23 recites the limitation "electronic transfer" is steps (d) through (f). The specification does not describe the "electronic transfer" in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear from either claim 23 or the disclosed specification whether the "electronic transfer" specifies "electronic transfer" of goods (game) from the gaming device to the user, or "electronic transfer" of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe "electronic transfer", the entity being transferred, and the parties between which the transfer is being completed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6, 8 and 11^f-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660.)

As to claim 1, Schneier et al teaches a gaming apparatus (see Abstract) comprising:

a portable biometric data storage device (see column 4, lines 47-57, where “biometric data storage device” is read on “optical storage unit”) storing first biometric data for at least a first user (see column 16, lines 14-27);

a gaming terminal (see Abstract, where “gaming terminal” is read on “player terminal”), configured for playing at least a first game (see column 7, lines 46-51);

a reader, coupled to the gaming terminal which receives the first biometric data stored on the biometric data storage device (see column 16, lines 7-10);

a biometric measurement device for measuring biometric data of a user to provide measured biometric data (see figure 3, and see column 6, lines 39-48); and

a comparator for comparing the measured biometric data to the first biometric data (see column 16, lines 10-27) and outputting at least a first notification if there is an absence of match (see column 16, lines 30-33.)

Schneier et al does not teach the biometric data storage device comprising a debit card, said biometric data storage device also storing personal preference data for said first user.

Sehr teaches an electronic ticketing system using multi-service visitor cards (see Abstract), in which he teaches the biometric data storage device comprising a debit card (see Abstract, and see paragraphs 49, 69, and 70), said biometric data storage device also storing personal preference data for said first user (see paragraph 46, where “personal preference data” is read on “seating information”, and see paragraphs 134 and 142.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al, by the teaching of Sehr, because the biometric data storage device comprising a debit card, would allow the same card to hold the user’s biometric information as well as his monetary information. The biometric data storage device comprising a debit card would allow the user to access his bank account (linked to the debit card), and/or the funds loaded to the debit card (pre-paid card), to play games and/or place wagers against games, using the same card that also holds his biometric identification data (see Sehr, Abstract), and because storing the user’s preference data, would enable the system to recognize such preferences and accommodate the users based on such preferences. Sehr teaches “when ordering the season pass, the visitor card will communicate the preferred seat locations, or desired price range for the tickets, to the seating map. The map will evaluate the request and assign the corresponding seating arrangements; if the requested seats are not available, the map will assign nearby seat locations” (see paragraph 134.)

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As to claims 6 and 13, Schneier et al as modified, teaches wherein:

the biometric measurement device is selected from among a thumb print scanner; a fingerprint scanner; a retina scanner; an iris scanner; an ear scanner; a voice data sensor; a facial scanner; or an infrared scanner (see Schneier et al, column 16, lines 7-13.)

As to claim 8, Schneier et al teaches a gaming method (see Abstract) comprising:

storing first biometric data for at least a first user (see column 16, lines 14-27) in a portable biometric data storage device (see column 4, lines 47-57, where “biometric data storage device” is read on “optical storage unit”);

providing a gaming terminal (see Abstract, where “gaming terminal” is read on “player terminal”);

coupling a reader to a gaming terminal, configured for playing at least a first game, wherein the reader receives the first biometric data stored on the card (see figure 3, and see column 16, lines 7-10);

measuring biometric data of a the first user to provide measured biometric data (see figure 3, and see column 6, lines 39-48); and

comparing the measured biometric data to the first biometric data (see column 16, lines 10-27) and outputting at least a first notification if there is an absence of match (see column 16, lines 30-33.)

Schneier et al does not teach biometric data storage device which comprises a debit card, and also storing personal preference data for said first user in said storage device; and also outputting said personal preference data.

Sehr teaches an electronic ticketing system using multi-service visitor cards (see Abstract), in which he teaches the biometric data storage device comprising a debit card (see Abstract, and see paragraphs 49, 69, and 70), and also storing personal preference data for said first user in said storage device (see paragraph 46, where “personal preference data” is read on “seating information”, and see paragraphs 134 and 142); and also outputting said personal preference data (see paragraph 46, where “outputting said personal preference data” is read on “forwarding” the requests “for seating” to the map/monitor via preferred seating information stored in the visitor card.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneider et al, by the teaching of Sehr, because the biometric data storage device comprising a debit card, would allow the same card to hold the user’s biometric information as well as his monetary information. The biometric data storage device comprising a debit card would allow the user to access his bank account (linked to the debit card), and/or the funds loaded to the debit card (pre-paid card), to play games and/or place wagers against games, using the same card that also holds his biometric identification data (see Sehr, Abstract), and because storing the user’s preference data; and outputting the preference data, would enable the system to recognize such preferences and accommodate the users based on such preferences. Sehr teaches “when ordering the season pass, the visitor card will communicate the preferred seat locations, or desired price range for the tickets, to the seating map. The map will evaluate the request and assign the corresponding seating arrangements; if the requested seats are not available, the map will assign nearby seat locations” (see paragraph 134.)

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As to claim 11, Schneier et al as modified teaches wherein:

the card is a debit card (see Sehr, Abstract, and see paragraphs 49, 69, and 70.)

As to claim 12, Schneier et al as modified teaches further comprising:

Storing, on the portable biometric data storage device (see Schneier et al, column 4, lines 47-57, where "biometric data storage device" is read on "optical storage unit"), the current account balance for an account established for the first user (see Sehr, paragraphs 73, 77, and 102.)

8. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660), as applied to claims 1, 6, 8 and 11-13 above, and further in view of Franchi (U.S. Patent No. 5,770,533.)

As to claims 27 and 28, Schneier et al as modified, still does not teach the player's winnings are credited to the current account balance.

Franchi teaches an open architecture casino operating system (see Abstract), in which he teaches the player's winnings are credited to the current account balance (see Abstract; column 3, lines 1-9; column 7, lines 55-62; column 9, lines 22-25; and see column 13, lines 45-50.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the teaching of

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Franchi, because including the player's winnings are credited to the current account balance, would provide for a totally cash-free playing, in which the player would not only be able to play without any real cash, coins, or chips, but also could have his winnings credited to his credit/debit/smart card conveniently. This would benefit the player in that he/she does not have to carry cash or tokens from one gaming table/device to another, and at "cash-out", and it would also benefit the gaming vendor/casino in that they would need less personnel to handle cash for players.

9. Claims 2-3, 5, 9-10, 15-17, 19 and 24-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660), as applied to claims 1, 6, 8 and 11-13 above, and further in view of Thompson (U.S. Patent No. 5,865,470.)

As to claims 2, 9, 16, and 25, Schneier et al as modified, does not teach wherein the card has a thickness of less than about 0.05 inch (although Sehr teaches using standard Credit/Debit cards and it is known in the art that standard Credit/Debit cards have a thickness less than 0.05 inch.)

Thompson teaches a tracking system utilizing microprocessor chip cards (see Abstract), in which he teaches wherein the card has a thickness of less than about 0.05 inch (see column 4, lines 45-49.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the teaching of

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Thompson, because wherein the card has a thickness of less than about 0.05 inch, would enable the card to be used with a standard credit/debit card reader, as taught by Thompson (see column 4, lines 45-49.)

As to claims 3, 10, and 17, Schneier et al as modified still does not teach wherein the card includes a microprocessor.

Sehr further teaches wherein the card includes a microprocessor (see paragraph 35, where “microprocessor” is read on “chip”).)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, with the further teaching of Sehr, because including wherein the card includes a microprocessor, would enable the card to input, store, process, output, and display data relating to events, cardholders and system entities, as well as to services rendered via the card, as taught by Sehr (see paragraph 35.)

As to claim 5, Schneier et al as modified teaches wherein:

the card further stores the current account balance for an account established for the first user (see Sehr, paragraphs 73, 77, and 102.)

As to claim 15, the applicant is kindly directed to the remarks and discussions made for claims 1 and 5 above.

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As to claims 19 and 26, Schneier et al as modified teaches wherein:

the biometric measurement device is selected from among a thumb print scanner; a fingerprint scanner; a retina scanner; an iris scanner; an ear scanner; a voice data sensor; a facial scanner; or an infrared scanner (see Schneier et al, column 16, lines 7-13.)

As to claim 24, the applicant is kindly directed to the remarks and discussions made in claim 1, 5, and 8 above.

Schneier et al as modified, still does not teach debiting an amount from the current account balance on the card as a fee for playing the game, and establishing a new current account balance on the card.

Sehr further teaches debiting an amount from the current account balance on the card as a fee for playing the game (see Abstract, and see paragraphs 49, 62, and 102, where “fee for playing the game” is read on “purchase”.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include debiting an amount from the current account balance on the card as a fee for playing the game.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the further teaching of Sehr, because debiting an amount from the current account balance on the card as a fee for playing the game, would keep the “current/updated” remaining balance on the user’s card each time a game is purchased, so that the current balance is compared against the fee of the

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next game to ensure that proper funds are available before the next game can be authorized for playing, as taught by Sehr (see paragraph 102.)

As to claim 30, Schneier et al as modified teaches in which the card has a thickness of less than about 0.05 inch (see Thompson column 4, lines 45-49.)

10. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660), and further in view of Thompson (U.S. Patent No. 5,865,470), as applied to claims 2-3, 5, 9-10, 15-17, 19 and 24-26 and 30 above and still further in view of Franchi (U.S. Patent No. 5,770,533.)

As to claim 29, Schneier et al as modified, teaches the card includes a microprocessor (see Sehr, paragraph 35) and in which the card further stores a current account balance for an account established by the first user (see Sehr, paragraphs 73 and 77.)

Schneier et al as modified, still does not teach in which the user's winnings from the play of the gaming apparatus are credited to the current account balance.

Franchi teaches an open architecture casino operating system (see Abstract), in which he teaches the user's winnings are credited to the current account balance (see Abstract; column 3, lines 1-9; column 7, lines 55-62; column 9, lines 22-25; and see column 13, lines 45-50.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include the user's winnings are credited to the current account balance.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the teaching of Franchi, because including the user's winnings are credited to the current account balance, would provide for a totally cash-free playing, in which the player would not only be able to play without any real cash, coins, or chips, but also could have his winnings credited to his credit/debit/smart card conveniently. This would benefit the player in that he/she does not have to carry cash or tokens from one gaming table/device to another, and at "cash-out", and it would also benefit the gaming vendor/casino in that they would need less personnel to handle cash for players.

Response to Arguments

11. Applicant's arguments filed on 09-June-2005 with respect to the rejected claims in view of the cited references have been fully considered but they are either not deemed persuasive or they are considered moot in view of the remarks and discussions provided in the new rejection of the amended claims:

In response to the applicant's arguments regarding the rejections made under 35 U.S.C 112 for claims 21 and 22, the arguments have been fully considered but are not found persuasive. The examiner does not agree with the applicant in that, "those skilled in the art would understand that an authenticator is present in the disclosure", and that "it is manifest and obvious that such an authenticator must be 'created', a property common to every manufactured item". While the examiner appreciates the applicant's explanation of the term

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“authentication” and its occurrences throughout the disclosed specifications, the examiner is maintaining the above rejections for claims 21-23 because as stated in this and the previous Office Actions, the specification does not describe “the *creation* of authenticator(s)” in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In response to the applicant’s arguments regarding the rejections made under 35 U.S.C. 112 for claim 23, the arguments have been fully considered but are not found persuasive. While the examiner agrees with the applicant that “the very essence of a debit card is electronic transfer at the request of the user”, it is still not clear from either the language recited in claim 23, or the disclosed specification, as to whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

Conclusion

12. The claims for which interference is being sought (claims 21-23) remain rejected in this Office Action, under 35 U.S.C. § 112 (paragraphs 3-5 of this Office Action.) Accordingly, interference proceedings will not be established at this time. Any future consideration for the interference proceedings would require overcoming the above mentioned rejections.


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13. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Gaffin, can be reached at (571) 272-4146.

tm

September 6, 2005



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
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